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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/963,227	11/03/97	ARLUWALIA	G 00216/289002

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ROBERT C NABINGER
FISH & RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804

EXAMINER

HARRISON, R

ART UNIT	PAPER NUMBER
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1617

23

DATE MAILED: 03/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/963,227

Applicant(s)
Ahluwalia et al

Examiner
Robert H. Harrison

Group Art Unit
1617



☒ Responsive to communication(s) filed on Jan 11, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26 and 28-78 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 30-45, 47-49, 51-55, and 63-73 is/are allowed.

☒ Claim(s) 1, 6, 9, 14, 21, 22, 28, 29, 46, 50, 56, 58, 61, 62, and 74-78 is/are rejected.

☒ Claim(s) 2-5, 7, 8, 10-13, 15-20, 23-26, 57, 59, and 60 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Receipt is hereby acknowledged of applicant's amendment and letter with formal drawings both filed as of January 11, 1999.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1617.

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 56, 58, 61, 62 and 74-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6k In claim 14, "said compound" lacks clear antecedent basis in claim 1 since this word did not appear in claim 1. Correction is deemed necessary.

The terms "derivative" or "derivatives" as well as "analog" are vague and indefinite since these terms could read on chemical derivatives or analogs as well as mechanical derivatives or analogs and in any case it is not clear what structures are encompassed thereby since such terms even encompass molecular fragments however small of the parent structure and thus one having skill in this art would not be able to determine whether

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the claims are being infringed by the prior art. Further definition is deemed necessary.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 9, 21, 22, 28, 29, 46, 50, 75, 76, 77, and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Golditch et al. or Lissak et al.

Either reference teaches administration of cimetidine which would inherently be an angiogenesis inhibitor which is being investigated or is contemplated for use in treating hirsutism which is encompassed by the instant claims. Although either reference appears to dispel the notion of its effectiveness in such a treatment, nevertheless either reference is applicable in the instant case because each reference recognizes such use whether beneficial or not. The manner in which the cimetidine is applied would inherently meet the claim limitations whether or not orally administered because if such active is administered orally, it would be expected to be applied however indirectly to all areas of the skin since cimetidine is taken up by such tissue when orally administered.

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Claims 74-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 74, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

PHU
03/03/99
Claims 2-^{5, 7, 8}~~8~~, 10-13, 15-20, 23 ^{through 57, 59 & 60} ~~and~~ 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 30-45, 47, 48, 49, 51-55, ~~57, 59, 60~~, 63 and 64-73 are allowed.

Any inquiry concerning this communication should be directed to Robert H. Harrison at telephone number (703) 308-2422.

Robert H. Harrison
Robert H. Harrison
Primary Examiner
Art Unit 1617

RHHarrison:cdc
March 3, 1999